

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are pending in the present application. Claims 1-4 and 8 are amended and new Claims 9-36 are added by the present amendment.

In the outstanding Office Action the title, specification, drawings, and Claims 1 and 3 were objected to; Claim 8 was rejected under 35 U.S.C. § 112, second paragraph; Claims 1, 2, and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,341,154 to Bird; Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird in view of U.S. Design Patent No. 409,583 to Nishida et al. (herein “Nishida”); Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Bird in view of U.S. Patent No. 6,546,231 B1 to Someya et al. (herein “Someya”); Claim 6 was rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Nishida and Someya; and Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Bird in view of *Microsoft Windows NT Workstation 4.0 User Manual* to Boyce.

Regarding the objections to the title, specification, drawings, and Claims 1 and 3, a new title is added that is clearly indicative of the invention to which the claims are directed and the specification is amended in light of the comments noted in the outstanding Office Action. Further, the specification is amended to refer to reference number 12 of Figure 1, and Claims 1 and 3 are amended in light of the comments noted in the outstanding Office Action. Accordingly, it is respectfully requested the objections to the title, specification, drawings and Claims 1 and 3 be withdrawn.

Also, the specification and abstract are amended to correct minor informalities. It is believed no new matter is added.

Claim 8 was rejected under 35 U.S.C. § 112, second paragraph. That rejection is respectfully traversed.

Claim 8 is amended in light of the comments noted in the outstanding Office Action and is directed to an information processing device in which display control means displays a processing item related to a graphical user interface (GUI). Accordingly, it is respectfully requested this rejection be withdrawn.

Claims 1, 2 and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird. That rejection is respectfully traversed.

Claim 1 is directed to an information a processing device including display control means for displaying a system menu showing a processing item based on an operating system program on a display screen based on an operation of the operating means.

In a non-limiting example, Figure 3 shows that when the CPU 10 of the notebook PC 1 detects that a user has operated the operating button B2 (step SP1:YES), then the system menu screen SM is pop-up-displayed in the center of the screen 31 as shown in Figure 4 (step SP2). As shown in Figure 3, the initial screen of the system menu screen SM shows an item for selecting a system setting, an item for selecting processing functions to be executed, and items for selecting other functions (power saving mode etc.), as described in the specification at page 8, lines 12-22.

As an advantage, even when the display body 30 is folded against the main body 20, the settings menu and the system menu can be displayed in the screen 31 that is disposed on the display body 30. Further, a desired item can be selected by operating the operating dial 32, so that it is easy for the user to perform a desired system operation. In addition, the settings menu and the system menu allow the user to customize the menu items by addition and deletion (see the specification at page 13, lines 2-11).

As stated in the outstanding Office Action, “Bird does not explicitly disclose a display control means for displaying a system menu showing processing items based on the operating system.” The outstanding Office Action also asserts that “it is well-known in the art that OS programs comprise of menus to allow the user to select from a number of applications to run, i.e., Microsoft windows ‘start menu.’” However, that grounds for rejection is traversed because a *prima facie* case of obviousness has not been made.

First, it is noted that M.P.E.P. § 2143.03 states that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USP 580 (CCPA 1974).

Accordingly, it is submitted that the outstanding rejection is deficient because the rejection does not set forth how the applied art anticipates at least the feature of Claim 1 of “display control means for displaying a system menu showing processing items.”

Although item 8 of the outstanding Office Action asserts that it is “well-known in the art that OS programs comprise of menus to allow the user to select from a number of applications to run ellipses,” it is submitted that this basis for rejection is deficient because it is an inappropriate reliance on taking official notice. M.P.E.P. § 2144.03 states that:

It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697; *Ahlert*, 424 F.2d at 1092, 165 USPQ 421.

Accordingly, as the outstanding rejection relies on purported common knowledge in the art without providing evidentiary support, it is respectfully submitted that that rejection is improper.

Moreover, the outstanding rejection is further improper because it does not set forth a proper motivation to modify the description of Bird. In particular, M.P.E.P. § 2143 states:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Further, M.P.E.P. § 2143.01 states that:

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

The outstanding rejection merely asserts that “it is also well-known in the art that OS programs comprise of menus to allow the user to select from a number of applications to run.” However, the outstanding rejection does not set forth any motivation or suggestion inherent in either Bird or in the generally available art to modify the system of Bird as suggested in the outstanding rejection.

Accordingly, it is respectfully submitted that rejection is deficient and it is respectfully requested that rejection be withdrawn.

Further, Nishida, Someya and Boyce also do not teach or suggest the features of independent Claim 1. Accordingly, the rejections of Claims 2-8, which depend on Claim 1, are similarly traversed for the above-stated reasons.

In addition, new Claims 9-36 are added to set forth the invention in a varying scope. New Claims 9-16 are similar to Claims 1-8 but are drafted not to use means-plus-function terminology, and these claims are believed to be allowable at least for similar reasons as Claims 1-8.

New Claims 17-24 are similar to Claims 1-8 but further include features of “selection of a first one of the processing items” that “configures at least one of a plurality of hardware input/output devices,” and that “selection of at least a second one of the processing items configures a communication setting,” support for which is found in the originally filed specification at least at page 7, lines 3-10.

In a non-limiting example, Figure 2 shows the operating button B2 is an operating means for operating a display of a system menu on the screen 31. This system menu is an item list of processes that are carried out based on the OS to perform system operations such as environment settings for user operation including setting of a hardware system (including system software) such as an input/output device, setting of communications and setting of a graphical user interface (GUI), as described in the specification at page 6, line 21, to page 7, line 10.

As an advantage, the information processing device can carry out system operations simply while the screen of the display body is viewed even when the display body is folded against the main body (see the specification at page 2, lines 15-19).

In contrast, Bird merely discusses that “by touching the stylus tip 78 to the display screen 35, the user is able to select an item from a menu being displayed” and that “the stylus can be manipulated like a pen to enter graphical information into the computer 10.”¹ However, Bird does not teach or suggest displaying processing items based on an operation of an operating means in which selection of at least one of the processing items configures at least one of a hardware input/output device and a communication setting, as in new Claim 17.

Accordingly, it is respectfully submitted new Claims 17-24 are allowable at least for similar reasons as Claims 1-8 and for the additional reasons discussed above.

¹ See Bird at column 7, lines 38-42.

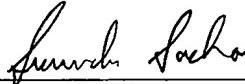
Further, new Claims 25-32 are similar to new Claims 17-24, but are drafted not to use means-plus-function terminology and it is believed no new matter is added. New Claims 25-32 are believed to be allowable at least for similar reasons as new Claims 17-24.

In addition, new Claims 33-36 recite that the configuration of the hardware input/output devices includes configuring at least one of "an external monitor output, a television output, screen luminance, and output volume," support for which is found in the specification at least at page 6, line 21, to page 7, line 10. New Claims 33-36 depend on new independent Claims 17, 19, 25, and 27, respectively, and are believed to be allowable at least for similar reasons as those independent claims.

Consequently, in light of the above discussion and in view of the present amendment, this application is believed to be in condition for allowance and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Surinder Sachar
Registration No. 34,423



22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
GJM:SNS:RR/cac

I:\ATTY\RR\PROSECUTION\213304\213304US-AM.DOC